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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,456

08/14/2006

Anita Mehta

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EXAMINER

NOLAN, JASON MICHAEL

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

02/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,456	Applicant(s) MEHTA ET AL.	
	Examiner JASON M. NOLAN	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to Applicants Amendment – After Non-Final Rejection, filed **11/21/2007**. **Claims 1-4, 6, & 8-14** are pending in the instant application; of which, **Claims 1, 2, 4, 6, & 8** are currently amended. **Claims 5 & 7** are canceled.

Response to Amendment

Applicant's amendments, with respect to **Claims 1, 2, 4, 6, & 8** have been fully considered and are entered. The 112-enablement rejection of **Claims 1, 4, & 8**; the 112-enablement rejection of **Claims 4 & 6**; and the objection to **Claim 2** are withdrawn per amendment. The ODP rejection over US Patent No. **7,232,835** and the provisional ODP rejection over US Serial No. **10/543,585** are maintained herein (the '**585** application has an earlier filing date). The provisional ODP rejections over US Serial Nos. **10/552,502** and **10/544,520** are maintained herein but may be withdrawn (they have later filing dates) if application is otherwise in condition for allowance.

Terminal Disclaimer

The terminal disclaimer filed on **11/21/2007** disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of US Patent No. **7,232,835** has been reviewed and is NOT accepted. According to 37 CFR 1.32 (a)(3), the disclaimer must state the present extent of patentee's ownership

interest in the patent application. Applicants have accidentally included the word “India” where “100%” should be. A substitute terminal disclaimer is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, & 8-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 1-38** of U.S. Patent No. **7,232,835** (US Serial No. **10/537,851**). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter. The compounds of the current application are not patentably distinct from those of the '**835** Patent because of the significant overlap within formulae I-VI of each case. Therefore, potential infringements upon the instant application would also be infringements upon the '**835** Patent.

Claims 1-4, 6, & 8-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 1-14, 21, & 23-32** of US Serial No. **10/543,585**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter. The compounds of the current application are not patentably distinct from those of the '**585** application because of the significant overlap within formula I of each case. Therefore, potential infringements upon the instant application would also be infringements upon the '**585** application.

Claims 1-4, 6, & 8-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 1-10, 15-17, & 27** of US Serial No. **10/552,502**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter. The compounds of the current application are not patentably distinct from those of the '**502**' application because of the significant overlap within formula I of each case. Therefore, potential infringements upon the instant application would also be infringements upon the '**502**' application.

Claims 1-4, 6, & 8-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 1-17** of US Serial No. **10/544,520**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter. The compounds of the current application are not patentably distinct from those of the '**520**' application because of the significant overlap within formula I of each case. Therefore, potential infringements upon the instant application would also be infringements upon the '**520**' application. *Note:* the structure of Formula I in the '**520**' application appears to be incorrect, (it is missing a bond, making it monocyclic). However, it appears to Examiner that the bond should be there because the synthetic precursor to Formula I is Formula V, which contains the bond. Further, the species in Claim 2 are bicyclic: 3-azabicyclo[3.1.0]-hexyl derivatives and appear on the search report as bicyclic compounds.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is Jason.Nolan@uspto.gov. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626

/Jason M. Nolan, Ph.D./
Examiner, Art Unit 1626